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P22,425-B USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: patent application of
Michael J. Picciallo

Application No.: **09/478,051**

Filed: **January 15, 2000**

For: **THIRD PARTY CREDIT ACCOUNT**

: Group Art Unit:

: Examiner:

: Date: **October 25, 2000**

X

Commissioner for Patents
Washington, D.C. 20231

**PETITION TO MAKE SPECIAL
BECAUSE OF ACTUAL INFRINGEMENT**

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Applicant hereby petitions to make this application special because of actual infringement. Accompanying this petition is a Statement of Fact in Support of this Petition to Make Special Because of Actual Infringement, and a Statement by Attorney in Support of this Petition to Make Special Because of Actual Infringement. Enclosed is a check in the amount of \$130.00 for the required fee pursuant to 37 C.F.R. §1.17(i).

If there are any additional charges in connection with this petition, the Examiner is authorized to charge applicant's Deposit Account No. 19-5425 therefor.

Respectfully submitted,

October 25, 2000

Peter J. Butch

Peter J. Butch III
Registration No. 32,203

Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107
Telephone (215) 923-4466

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**STATEMENT OF FACTS IN SUPPORT OF PETITION
TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**

I, Michael J. Picciallo, of 142 North Sussex Street, Dover, New Jersey 08701, am the inventor of the above-identified invention and I hereby state the following:

1. There is an actual infringement of my invention. I recently became aware of the Visa Buxx card being offered by banks such as Bank of America, and others. I learned that Bank of America and Visa were offering stored value card accounts for teenagers funded by parents from the parent's check card, credit card, checking account or savings account. The parents can designate a frequency by which the account can be periodically and automatically recharged with what essentially is an allowance payment.

2. This is exactly the computer-based method described in my patent application at page 19, lines 9-12. Furthermore, this is exactly the computer-based method to which claims 60-62 of my patent application are directed. These claims define a method in which a customer account file is provided containing a record of funds deposited for use by third parties. In response to command instructions from fund depositors, the accounts may be periodically and automatically recharged.

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3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title XIX of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 10/22/2000

Michael J. Picciallo
Michael J. Picciallo

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**STATEMENT OF FACT IN SUPPORT OF PETITION
TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**

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I, Peter J. Butch III of Synnestvedt & Lechner LLP, 2600 Aramark Tower, 01
Market Street, Philadelphia, Pennsylvania 19107, Registration No. 32,203, Telephone No.
(215) 923-4466, am the attorney of record and the practitioner for the applicant in this case
and make the following statements:

1. I have made a rigid comparison of the alleged infringing method of Bank Of
America's Visa Buxx Card referred to in the accompanying Declaration of Michael J.
Picciallo with the claims of this application. A comparison was made of information
presented on Bank of America's website ("Bank of America Visa Buxx frequently asked
questions (FAQ)") attached hereto as Exhibit "A", with presently pending claims 60-62. As
shown in the margin of Exhibit A, this information was posted on and downloaded from the
Bank of America Visa Buxx web page on October 22, 2000 and represents up to date
information. The comparison is set forth beginning on page two of this statement.

Claims

Bank of America's Visa Buxx Card

60. A computer-based method for transferring funds to third parties comprising:

creating for each third party a customer account file containing a record of funds deposited by a depositor for use by each third party; and

periodically depositing funds into a customer account file in response to command instructions from said fund depositor.

61. The method of claim 60, wherein said funds are deposited weekly or monthly.

62. The method of claim 60, wherein said funds are deposited automatically.

"[The] Bank of America Visa Buxx card is ... a stored value card ... [for use by children] to access [amounts] loaded onto the card by ... parents." (FAQ at pg. 3.)

"Parents may establish separate accounts for each teen in their family. Each teen will receive his or her account with a unique card number. Parents will be able to add money to and monitor each account separately." (FAQ at pgs. 4-5.)

"Once they have registered a funding account, they can save time by determining the frequency and value of the load ..." (FAQ at pg. 8.)

"... just like an allowance." (FAQ at pg. 8.)

"... the money will be automatically deducted from the funding account and credited to your Bank of America Visa Buxx card." (FAQ at pg. 8.)

2. In my opinion, at least claims 60-62 on file in this application are unquestionably infringed. Further investigation would be needed to determine whether the other method claims and the computer system claims are also infringed. Clearly, however,

Bank of America, through the Visa Buxx Card, is practicing the gist of applicant's claimed invention. Applicant's basic concept was to establish an allowance in the form of a credit or debit card. As stated at specification page 19, lines 9-12:


The amount of funds to be transferred is also specified. The transfer can be established as a one-time only event, or it can be programmed to occur periodically, i.e., daily, weekly, monthly, and the like. The periodic transfer can be programmed automatically...

3. I have made a search of the pertinent prior art. All such material has been cited to the Examiner in two Information Disclosure Statements, one filed with this application, and one with the within petition. The second Information Disclosure Statement was prepared to cite for the record prior art provided to us by a party accused of infringing applicant's U.S. Patent No. 5,044,360. The accused party ultimately dropped the disputed subject matter, but has since applied for a license. Given that the prior art cited to the Patent Office includes material supplied by an accused infringer, it is submitted that our prior art searching has been exceptionally thorough and, in effect, double-checked.

4. I believe that all claims in this application as on file are allowable. At the very least, there is no teaching or suggestion in the prior art of the subject matter of claim 62, which is directed to a method in which a credit account is established for use by a third party into which funds are deposited both periodically **and** automatically.

5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title XIX of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: October 25, 2000



Peter J. Butch III
Registration No. 32,203